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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,844	09/08/2003	John M. Morales	026595-007510US	5408
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TOWNSEND AND TOWNSEND AND CREW, LLP			GRAHAM, CLEMENT B	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/658,844	MORALES ET AL.
	Examiner Clement B. Graham	Art Unit 3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 October 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-22 remained pending.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-22, are rejected under 35 U.S.C. 102(e) as being anticipated by Sziklai et al (Hereinafter Sziklai U.S Pub: 20050080710).

As per claim 1, Sziklai discloses a method of producing a suspicious activity report, comprising:

storing configuration information at a transaction processing device, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24) receiving transaction information;

determining, based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared; and generating a suspicious activity report containing at least some of the transaction information. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 2, Sziklai discloses further comprising transmitting the suspicious activity report to authorities. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 3, Sziklai discloses wherein transmitting the suspicious activity report to authorities comprises:

collecting suspicious activity reports at a host computer system; and transmitting the collected suspicious activity reports to a computer system of the authorities. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 4, Sziklai discloses further comprising receiving additional information and including the additional information in the suspicious activity report. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 5, Sziklai discloses wherein generating a suspicious activity report comprises:

printing a suspicious activity report having a portion of the additional information and also having blanks for receiving additional suspicious activity report information. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 6, Sziklai discloses wherein the certain criteria comprises a mandatory SAR threshold. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24). As per claim 7, Sziklai discloses wherein determining whether a suspicious activity report is to be prepared comprises comparing an amount of a transaction to the mandatory SAR threshold. (Note abstract and see column 1 lines 52-67 and column 2 lines 1-9 and column 6 lines 66-67 and column 7 lines and 14 lines 20-35).

As per claim 8, Sziklai discloses wherein the certain criteria comprises a SAR prompt threshold. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24). As per claim 9, Sziklai discloses wherein determining whether a suspicious activity report is to be prepared comprises comparing an amount of a transaction to the SAR prompt threshold(see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 10, Sziklai discloses wherein determining whether a suspicious

activity report is to be prepared further comprises:

displaying a prompt that asks an operator if he wants to prepare a suspicious activity report, and receiving a response to the prompt. (see column 30 lines 26-30 and column 8 lines 25-41 and column22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 11, Sziklai discloses wherein determining whether a suspicious activity report is to be prepared comprises determining whether an operator has elected to produce an on-demand SAR. (see column 30 lines 26-30 and column 8 lines 25-41 and column22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 12, Sziklai discloses further comprising printing a report relating to suspicious activity reports produced at the transaction processing device during a period of 3 time. (see column 30 lines 26-30 and column 8 lines 25-41 and column22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 13, Sziklai discloses wherein the transaction processing device is configured to print money orders. (see column 30 lines 26-30 and column 8 lines 25-41 and column22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 14, Sziklai discloses a transaction processing device, comprising: an input device arranged to receive transaction information and SAR 3 information, a display screen arranged to display information to an operator; and application software that programs the transaction device to: store configuration information, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria, receive transaction information. (see column 30 lines 26-30 and column 8 lines 25-41 and column22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24) determine based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared; and generate a suspicious activity report containing at least some of the transaction information. (see column 30 lines 26-30 and column 8 lines 25-41 and column22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 15, Sziklai discloses wherein the certain

criteria comprises a mandatory SAR threshold. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 16, Sziklai discloses wherein the application software also programs the transaction device to compare an amount of a transaction to the mandatory SAR threshold. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 17, Sziklai discloses wherein the certain criteria comprises a SAR prompt threshold. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 18, Sziklai discloses wherein the application software also programs the transaction device to compare an amount of a transaction to the SAR prompt threshold. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 19, Sziklai discloses wherein the application software further programs the transaction device to:

display a prompt that asks an operator if he wants to prepare a suspicious activity report; and receive a response to the prompt. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 20, Sziklai discloses wherein the application software also programs the transaction device to determine whether an operator has elected to produce an on-demand SAR. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 21, Sziklai discloses wherein the application software further programs the transaction device to print a report relating to SARs produced at the transaction processing device during a period of time. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

As per claim 22, Sziklai discloses wherein the transaction processing device is configured to print money orders. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

Conclusion

RESPONSE TO arguments

4. Applicant's arguments filed 10/17/07 has been fully considered but they are moot in view of new grounds of rejections.

5. In response to Applicant's arguments that Sziklai fail to teach or suggest" storing configuration information at a transaction processing device, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria receiving transaction information, determining, based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared, and generating a suspicious activity report containing at least some of the transaction information" the examiner disagrees with Applicant's because these limitations were addressed as stated

Sziklai discloses storing configuration information at a transaction processing device, wherein the configuration information configures the device to produce suspicious activity reports based on certain criteria. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24) receiving transaction information, determining, based on the transaction information and the certain criteria, whether a suspicious activity report is to be prepared; and generating a suspicious activity report containing at least some of the transaction information. (see column 30 lines 26-30 and column 8 lines 25-41 and column 22 lines 12-20 and column 23 lines 65-67 and column 24 lines 1-24).

Further storing configuration information at a transaction processing device, and configuration information configures the device to produce suspicious activity reports. However configures the device to produce suspicious activity reports is not a positive step because the device only configured to produce its not actually producing any reports.

6. Applicant's claims 1, 26, 48, 73, 95, 120, states "**wherein the configuration information configures the device to produce, and arrange to produce and arrange to display and transaction device to store configuration information and configuration information configures the device to produce reports**"

However the subject matter of a properly construed claim is defined by the terms that limit its

scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

**>USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed.

Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

Dec 16, 2007


FRANTZY POINVIL
PRIMARY EXAMINER
